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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,820	10/24/2003	Chester Ledlie Sandberg	5659-20900/EBM	1426

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EXAMINER

JEFFERY, JOHN A

ART UNIT

PAPER NUMBER

3742

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/693,820

Applicant(s)

SANDBERG ET AL.

Examiner

John A. Jeffery

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 409-465 is/are pending in the application.
- 4a) Of the above claim(s) 415 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 409-414, 416-465 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>numerous</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Acknowledgement of Elected Species***

Applicant's election of Species C(2) and D(1) from Species Groups C and D respectively without traverse is acknowledged. Also, the examiner acknowledges applicant's election with traverse of Species A(1), B(1), and E(1) from Species Groups A, B, and E respectively. Accordingly, claim 415 is withdrawn from consideration as being directed to nonelected species.

Regarding Species A(1), the traversal is on the ground that species (2)-(4) are subsets of species (1). Remarks, at 2. However, species (1) consists of embodiments with heaters and methods of heating comprising a single ferromagnetic material only (i.e., without any additional material (ferromagnetic or non-ferromagnetic). Moreover, examining the multiple species of Species Group A imposes a serious burden on the examiner since not only have such structures achieved a separate status in the art, they each inherently give rise to a separate field of search despite some overlap in the field of search. See MPEP § 808.02.

Regarding Species B(1) and E(1), applicant traverses on the ground that none of the currently pending claims reads on the respective species groups. Although the currently pending claims may not read on the listed species, the species are nonetheless disclosed and patentably distinct from each other. Moreover, given the unusually vast number of disclosed patentably distinct species in the instant application, and the possibility that the scope and content of the claims could change during

Art Unit: 3742

prosecution which may necessitate a later election of species, imposing an election of disclosed patentably distinct species at this time is proper. Moreover, identification of disclosed patentably distinct species as early as possible during prosecution – particularly when an unusually vast number of species is disclosed (as is the case here) -- ensures compact prosecution on the merits and avoids piecemeal examination that could result from subsequent election of species requirements. See MPEP § 707.07(g) (“Piecemeal examination should be avoided as much as possible.”).

The requirement is still deemed proper and is therefore made FINAL.

***Joint Inventors -- Common Ownership Presumed***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

***Claim Rejections - 35 U.S.C. § 103(a)***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3742

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 409-411, 418-435, 437, 439-442, 445-455, 458-465 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP130671 in view of Holen (US 2002/0028070). EP130671 discloses a fluid electric heater (P. 17 and Fig. 4) comprising ferromagnetic materials configured such that the heater automatically reduces its heat output near or above a selected temperature (Curie temperature of the ferromagnetic material). The heater autoregulates its temperature about the Curie temperature via its intrinsic resistance. See abstract and P. 13, lines 3-14. The heater is connected to an AC source with a frequency of 50 Hz – 10 KHz. See P. 8, line 19-23.

Regarding claims 418 and 458, EP130671 discloses a number of different iron-nickel alloys with varying Curie temperatures suitable as ferromagnetic materials for autoregulating electric heaters. See P. 14, Table I (noting that iron-nickel alloys have relatively lower Curie temperatures compared to other ferromagnetic materials).

Regarding claim 432, the limitation that the selected temperature is "within about 50 °C of the Curie temperature of the ferromagnetic material" fully reads on EP130671 since the selected temperature disclosed in EP130671 (i.e., the Curie temperature) falls within the claimed range.

Regarding claim 419 and 442, see P. 9, lines 24-26.

Regarding claim 422, see P. 6, lines 24-28.

Regarding claim 446, because (1) the heater of EP130671 utilizes the skin effect of the conductor to ultimately dictate its heating, (2) the inverse relationship between frequency and skin depth is well known (see P. 2, lines 11-28), and (3) a wide frequency range of 50 Hz – 10 KHz is envisioned (see P. 8, line 19-23), the heater of EP130671 would inherently control the skin depth in the conductor by varying the applied frequency.

The claims differ from EP130671 in calling for the AC voltage to be above about 200 volts. But powering ferromagnetic heaters with such voltages to heat petroleum-based fluids is well known in the art. Holen (US 2002/0028070), for example, discloses applying a voltage from 5-40 kV to heat a ferromagnetic tube to heat the fluid therein. See Paras. 0010, 0011, and 0015. Such a voltage ensures that the petroleum-based fluids are sufficiently heated to maintain an adequate viscosity. In view of Holen (US 2002/0028070), it would have been obvious to one of ordinary skill in the art at the time of the invention to power the ferromagnetic heater of EP130671 with 200 V or more to ensure that petroleum-based fluids are sufficiently heated to maintain an adequate viscosity.

Regarding claims 419, 420, 421, 422, 427, 439, 440, 442, 459, 460, and 463, no criticality is seen in the specific values of reduced heat above or near the selected temperature, turndown ratio, the ferromagnetic material's thickness and length, the conductor's resistance as a function of temperature, and heat output reduction in lieu of the autoregulating heater disclosed in the prior art. Moreover, the specific values claimed merely optimize result-effective variables well within the scope of routine

Art Unit: 3742

experimentation by skilled artisans depending on the desired temperature and heat output.<sup>1</sup> It is well settled that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233,235 (CCPA 1955).

Claims 412, 413, 416, 436, 438, 443, and 456 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP130671 in view of Holen (US 2002/0028070) and further in view of Pritchett (US 3,757,860). Pritchett (US 3,757,860). The claims differ from EP130671 in calling for configuring the heater to heat a subsurface formation. But heating subsurface formations with ferromagnetic electric heaters that utilize skin effect heating is well known in the art. Pritchett (US 3,757,860), for example, discloses a well heater comprising an AC generator 15 connected to ferromagnetic (steel) casings or pipes 11 and 4 to heat the casings as well as the surrounding subsurface formation by the intrinsic skin effect as electric current flows through the pipes' ferromagnetic material. Thus, the viscosity of liquid produced in the well (i.e., hydrocarbons) is reduced. See abstract, col. 3, lines 19-40, col. 5, line 63 – col. 6, line 61, and the figure. With such a ferromagnetic skin effect heater, the formation can be heated directly by merely connecting AC to a long metallic structure that is buried within the formation, such as a ferromagnetic pipe or casing. In view of Pritchett (US 3,757,860), it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the autoregulating ferromagnetic electric heater to heat subsurface hydrocarbon-

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<sup>1</sup> Further evidence of such engineering design considerations can be found in *Recommended Practice for*

Art Unit: 3742

producing formations to reduce the hydrocarbons' viscosity thereby enhancing recovery. Such an arrangement enables heating the formation by merely connecting AC to a long metallic structure that is buried within the formation, such as a ferromagnetic pipe or casing.

Claims 414, 444, and 457 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP130671 in view of Holen (US 2002/0028070), Pritchett (US 3,757,860), and further in view of Vanegmond et al. (US 4,572,299). The claims differ from the previously cited prior art in calling for heating the hydrocarbon material at or above a pyrolysis temperature. But heating subsurface hydrocarbon formations at or above pyrolysis temperatures is well known in the art as evidenced, for example, by Vanegmond et al. (US 4,572,299) in col. 1, line 39 – col. 2, line 7. As is well known in the art, heating formations at or above pyrolyzing temperatures to enable recovery of hydrocarbons from the formation. In view of Vanegmond et al. (US 4,572,299), it would have been obvious to one of ordinary skill in the art at the time of the invention to heat the formation at or above pyrolyzing temperatures to enable recovery of hydrocarbons from the formation.

Claim 417 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP130671 in view of Holen (US 2002/0028070) and further in view of CA2152521. The claim differs from the previously cited prior art in calling for a three-phase power source.



Art Unit: 3742

But powering a downhole ferromagnetic electric heater with a three-phase power source is well known in the art as evidenced, for example, by CA2152521 noting Figs. 11 and 12 and P. 32, line 11 – P. 35, line 21. As is well known in the art, three phase loads take advantage of the higher voltage and power level associated with three-phase power distribution. In view of CA2152521, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a three-phase power source in the previously described apparatus to take advantage of the higher voltage and power level associated with three-phase power distribution.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 3742

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 409-414 and 416-465 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 466-518 of copending Application No. 10/693,700 in view of Holen (US 2002/0028070). The claims differ from the claims of the '700 application in calling for the AC voltage to be above about 200 volts. But powering ferromagnetic heaters with such voltages to heat petroleum-based fluids is well known in the art. Holen (US 2002/0028070), for example, discloses applying a voltage from 5-40 kV to heat a ferromagnetic tube to heat the fluid therein. See Paras. 0010, 0011, and 0015. Such a voltage ensures that the petroleum-based fluids are sufficiently heated to maintain an adequate viscosity. In view of Holen (US 2002/0028070), it would have been obvious to one of ordinary skill in the art at the time of the invention to power the ferromagnetic heater of the '700 application with 200 V or more to ensure that petroleum-based fluids are sufficiently heated to maintain an adequate viscosity.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 409-414 and 416-465 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 268-408, 625, 659, 685, and 710 of copending Application No. 10/693,816 in view of Holen (US 2002/0028070). The claims differ from the claims of the '816 application in calling for the AC voltage to be above about 200 volts. But powering ferromagnetic heaters with such voltages to heat petroleum-based fluids is well known in the art. Holen (US 2002/0028070), for example, discloses applying a voltage from 5-40 kV to heat a ferromagnetic tube to heat the fluid therein. See Paras. 0010, 0011, and 0015. Such a voltage ensures that the petroleum-based fluids are sufficiently heated to maintain an adequate viscosity. In view of Holen (US 2002/0028070), it would have been obvious to one of ordinary skill in the art at the time of the invention to power the ferromagnetic heater of the '816 application with 200 V or more to ensure that petroleum-based fluids are sufficiently heated to maintain an adequate viscosity.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Other Pertinent Prior Art***

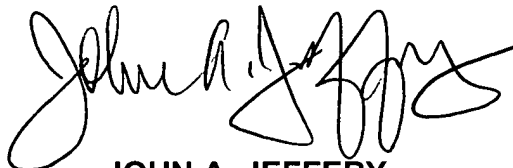
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should (1) separately consider the art, and (2) consider the art together with the previously cited prior art for potential applicability under 35 U.S.C. §§ 102 or 103 when responding to this action. US 313 is related to the instant application.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Jeffery whose telephone number is (571) 272-4781. The examiner can normally be reached on Monday - Thursday from 7:00 AM to 4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans, can be reached on (571) 272-4777. All faxes should be sent to the centralized fax number at (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**JOHN A. JEFFERY**  
**PRIMARY EXAMINER**

**12/11/05**